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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/049,587	02/12/2002	Douglas E. Brenneman	15280W-0021US	9701

7590 07/02/2007
Annette S Parent
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San Francisco, CA 94111-3834

EXAMINER

STANDLEY, STEVEN H

ART UNIT	PAPER NUMBER
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1649

MAIL DATE	DELIVERY MODE
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07/02/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/049,587

Applicant(s)

BRENNEMAN ET AL.

Examiner

Steven H. Standley

Art Unit

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 April 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213:

Disposition of Claims

- 4) ☒ Claim(s) 1,5,6,8,9,19,23,24 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) 46-52 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,8,9 and 19 is/are allowed.
- 6) ☒ Claim(s) 5,6,23,24,42-46 and 53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/05/2006 has been entered.

2. Claims 1, 5-6, 8-9, 19, and 23-24 and 42-53 are under consideration.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior office action.

The amendment filed 3/21/07 has been made of record. The text of those sections of Title 35, U.S. Code, not included in this action can be found in a prior office action. Claims 1, 5-6, 8-9, 19, 23-24 and 42-53 are under consideration. Applicant is reminded that now claims 46-52 are directed to non-elected species (ADNFIII plus ADNFI). See the objection below.

Objections/Rejections: Maintained/New Grounds

Claim Rejections - 35 USC § 103

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3. Rejection of claims 1, 8-9, 19, 24, 42-43, and 45 under 35 USC § 103(a) is withdrawn due to applicant's amendment and arguments. Although at least 4 separate short polypeptides have been shown to retain their activity in all-D form, this is not an expected result. See evidence cited by examiner in form 892.

Objections/Rejections: Maintained/New Grounds

Claim Objections

4. Objection to claims 46-52 is maintained for the reasons made of record in the office action dated 3/14/06 and 10/19/06. Applicant's arguments have been fully considered and not found to be persuasive. Applicant argues the claims have been amended. This is not found persuasive because claims 46-52 are to mixtures of ADNFI and ADNFIII, which was not the elected invention. The elected invention is group I, wherein group I is directed to ADNF I and a method of reducing neuronal cell death by administration of ADNFI.

5. Claims 5-6 and 23-24, and 43-45 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 6 and 24 recite an ADNF I polypeptide consisting of all D-amino acids. However, one interpretation of the claim is that this limitation is already present in base claim 1. See the rejection under 35 USC § 112, 2nd.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 5-6, 23-24, 42-45 and 53 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 5 (and 23 and 44) reads, "the adnf I polypeptide of claim 1, wherein the ADNF I polypeptide consists of [SEQ ID NO: 1]." Thus, the claim can be read as no longer requiring each amino acid to be D-amino acids. This interpretation is further reinforced by claim 6 (and 24 and 45), wherein the D-amino acid limitation is restated. Claim 5 and 23 and 44 can also be interpreted to be already limited to the all D- amino acid form. It's not clear that claims 5 and 23 and 42 and 44 are limited to the all-D amino acid forms or not. Claims 6, 24, 43, 45 and 53 are rejected as they depend from the rejected claims.

Claim Rejections - 35 USC § 103

7. Rejection of claims 5, 23, and 44 under 35 USC § 103(a) is maintained for the reasons made of record in the office action dated 3/14/06 and 10/19/06. In particular, because it is unclear in the above claims whether applicant is claiming an ADNF I polypeptide that is not comprised of all D-amino acids, the rejection is maintained. See the rejection of record in the office actions dated 3/14/06 and 10/19/06.

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Conclusion

Claims 1, 8-9 and 19 are allowable.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Steven H. Standley whose telephone number is (571) 272-3432. The examiner can normally be reached on 8:00-4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Christina Chan can be reached on (571) 272-0841. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Steven Standley, Ph.D.

6/21/07

/DAVID ROMEO/
PRIMARY EXAMINER
Art Unit 1647